

### **AMENDMENTS TO THE DRAWINGS**

The attached "Replacement Sheet" of drawings includes changes to Figure 2. The attached "Replacement Sheet," which includes Figure 2, replaces original sheet 2 of the drawings. Applicant has also included a marked-up copy of this drawing sheet.

Applicant has canceled Figures 4 and 5 from the application. As these figures were the only drawings on sheet 3 of the originally filed drawings, Applicant has included a marked-up copy of this drawing sheet including an annotation showing that the drawings (i.e., Figures 4 and 5) have been canceled.

Attachment: Replacement Sheet and Annotated Sheets Showing Changes.

### **REMARKS**

Claims 19-25 are now pending in the application. Minor amendments have been made to the specification and claims to simply overcome the objections to the specification and rejections of the claims under 35 U.S.C. § 112. The amendments to the claims contained herein are intended to broaden the scope thereof and, thus, are not a narrowing amendment. The examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

### **RESTRICTION REQUIREMENT**

The examiner has entered a restriction requirement in the present application, stating that "Claim 24 is directed to an invention that is independent or distinct from the invention originally claimed".

Applicant notes that the term "independent" means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect. MPEP §802.01. As the examiner has noted, however, there is a disclosed relationship between Claim 24 and the remainder of the claims - i.e., process of making and product made.

Applicant notes that the term "distinct" means that "the two or more subjects as disclosed are related, for example, as ... process and product made, etc., but are capable of separate manufacture, use or sale as claimed AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER". MPEP §802.01.

Applicant submits that Claim 24 is not independent from the remainder of the claims pending in the present application as Claim 24 is not unconnected with the

remainder of the claims pending in the application in design, operation or effect from the remainder of the claims. Applicant submits that Claim 24 is not distinct from the remainder of the claims pending in the present application for the reasons set forth by the examiner (i.e., “the product as originally claimed can made by another and materially different process because the product could be made without shafts and/or splines”). Applicant submits that “shaft” and “spline” elements found in Claim 24 are also included in independent Claims 19 and 25 (the only other independent claims pending in the application) and as such, the two groups of claims cannot be separately patentable over each other for the reason stated by the examiner. Accordingly, Applicant respectfully requests that the examiner reconsider and withdraw the restriction requirement.

#### **DRAWINGS**

The attached “Replacement Sheet” of drawings includes changes to Figure 2. Reference numerals 55A and 55B have been added to Figure 2. Applicant has also included a marked-up copy of this drawings sheet.

Applicant has canceled Figures 4 and 5 from the application. As these figures were the only drawings on sheet 3 of the originally filed drawings, Applicant has included a marked-up copy of this drawing sheet including an annotation showing that the drawings (i.e., Figures 4 and 5) have been canceled.

### **REJECTION UNDER 35 U.S.C. § 112**

Claims 19 through 23 and 25 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The examiner has stated that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

As the examiner knows, “adequate description under the first paragraph of 35 U.S.C. 112 does not require *literal* support for the claimed invention ... Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed.” *Ex parte Parks*, 30 USPQ2d 1234 (BPAI 1994). As the examiner also knows, there is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ2d 90, 96 (CCPA 1976).

Concerning the axial spacing of the annular groove relative to the axial end of the first shaft, Applicant notes that the patent application as filed, conveys with reasonable clarity to a person of ordinary skill in the art that the mating groove 55 is proximate but spaced apart from an axial end of the shaft 24. Applicant notes that this is clearly shown in Figure 2.

Concerning the first and second sidewalls of the annular groove, Applicant notes that the patent application as filed, conveys with reasonable clarity to a person of ordinary skill in the art that the mating groove 55 includes a first sidewall and a second sidewall that

is spaced apart from the first sidewall in an axial direction along the output shaft. Applicant notes that this is clearly shown in Figure 2.

Concerning the slidable interconnection of the first and second shaft, Applicant notes that the patent application, as filed conveys with reasonable clarity to a person of ordinary skill in the art that the internally splined output shaft 24 and the externally splined shaft 20 are slidably connected to one another. Applicant notes that it is common practice in the art for powertrains to utilize splined shafts that permit telescoping (i.e., relative axial movement) and given that the present invention is disclosed in conjunction with the transfer case, one of ordinary skill in the art would appreciate from Applicant's disclosure that the internally splined output shaft 24 and the externally splined shaft 20 are slidably connected to one another. Moreover, Applicant notes that it is not clear how the output shaft 24 and the shaft 20 would be assembled to one another if the two were not slid together (i.e., this functionality is inherent).

Concerning the abutment of the flange seal against the first sidewall, Applicant notes that the patent application, as filed, conveys with reasonable clarity to a person of ordinary skill in the art that the attachment portion 54 abuts the first sidewall to thereby retain the flange seal portion 50 to the splined shaft 24. See Figure 2.

Applicant refers the examiner to the procedure in MPEP 2163.04 regarding the initial burden on the examiner with regard to the written description requirement. More specifically, Applicant notes that the examiner has not established a *prima facie* case as the examiner has not provided reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.

In view of the above remarks, Applicant respectfully submits that no reasonable person of ordinary skill in the art would view the above limitations as not being supported and as such, Applicant respectfully submits that the examiner has not presented a *prima facie* case of no written description. Accordingly, Applicant respectfully requests that the examiner reconsider and withdraw the rejection of Claims 19 through 23 and 25 under 35 U.S.C. §112, first paragraph.

#### **SPECIFICATION**

Applicant has amended the specification to further moot the §112, first paragraph issues raised by the examiner. Applicant submits that bases for the amendment can be found throughout the application, claims and drawings as originally filed and as such, no new matter has been presented. More specifically, Applicant submits that:

- The patent application, as filed, conveys with reasonable clarity to a person of ordinary skill in the art that the internally splined output shaft 24 and the externally splined shaft 20 are slidably connected to one another. Applicant notes that it is common practice in the art for powertrains to utilize splined shafts that permit telescoping (i.e., relative axial movement) and given that the present invention is disclosed in conjunction with the transfer case, one of ordinary skill in the art would appreciate from Applicant's disclosure that the internally splined output shaft 24 and the externally splined shaft 20 are slidably connected to one another. Moreover, Applicant notes that it is not clear how the output

shaft 24 and the shaft 20 would be assembled to one another if the two were not slid together (i.e., this functionality is inherent).

- The patent application as filed conveys with reasonable clarity to a person of ordinary skill in the art that the mating groove 55 includes a first sidewall and a second sidewall that is spaced apart from the first sidewall in an axial direction along the output shaft. Applicant notes that this is clearly shown in Figure 2.
- The patent application, as filed, conveys with reasonable clarity to a person of ordinary skill in the art that the mating groove 55 is proximate but spaced apart from the axial end of the output shaft 20. See Figure 2.
- The patent application, as filed, conveys with reasonable clarity to a person of ordinary skill in the art that the attachment portion 54 abuts the first sidewall to thereby retain the flange seal portion 50 to the splined shaft 24. See Figure 2.

Applicant submits that the changes made to the application disclosure are supported, directly or inherently, by the originally filed specification, drawings and claims as interpreted by one of ordinary skill in the art.

## **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office

Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael D. Zalobsky', written over a horizontal line.

By: \_\_\_\_\_

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